

REMARKS

This is in response to the Office Action that was mailed on December 30, 2003. The amendment to claims 1, 3, and 8 specify that the drive source is adapted to perform the specified actions, as expressly requested by the Examiner near the bottom of page 3 of the Office Action. The recitations of claim 8 are also rearranged somewhat for greater clarity. Claim 9 is amended as implicitly requested by the Examiner at the top of page 4 of the Office Action. No new matter is introduced by this Amendment. Entry of this Amendment in order to place the application into condition for allowance, or into better condition for appeal, is respectfully solicited. It is noted that the only substantive amendments herein, of claims 1, 3, 8, and 9, are made solely at the request of the Examiner, and that they have no impact on the prior art rejections. With this Amendment, claims 1-14 remain in the application.

The Examiner is respectfully requested to indicate acceptance of the corrected drawings that were filed on October 7, 2003.

The Examiner is respectfully request to acknowledge the Information Disclosure Statement that was filed on July 6, 2001.

Applicants gratefully acknowledge the Examiner's indication – on page 10 of the Office Action – that claims 3, 5, 8, and 12 would be allowable if rewritten

in independent form. These claims have now been rewritten in independent form, so that claims 3, 5, 8, and 12 are now allowable.

Claim 11 is rejected under the second paragraph of 35 U.S.C. § 112. Office Action, page 3, middle. The Examiner is respectfully requested to reconsider and withdraw this rejection.

On page 4 of the Office Action, the Examiner offers certain observations concerning claims 9-11. Claim 9 is amended based upon the Examiner's observations. Regarding claims 10 and 11, the Examiner alleges that it is unclear how the device is referred to as a hematology analyzer when no analyzing structure is claimed in the claims. Claims 10 and 11 are drawn to hematology analyzers "comprising" specified features. In U.S. patent practice, this means that they must have at least the specified features, but that they can also have any other features – such as analyzing structures – so long as the other features do not deprive them of their stated function, "hematology analyzer". The Examiner notes that claims 10 and 11 claim elements in relationship to unclaimed elements, that is, storing racks and specimen vessels. Claim 10 is drawn to a hematology analyzer comprising a sample suction apparatus and a conveyor. Claim 11 is drawn to a hematology analyzer comprising a rack storage part, a track transferring part, a sample suction apparatus, and a rack collection part. The scopes of these claims are clear. Applicants are not required to include in their claims details that are only

tangential to the essence of their invention, which invention is expressed in their novel and unobvious sample suction apparatus.

THE INVENTION. In conventional sample suction apparatuses, two drive sources are employed to independently move the vessel supporting means, the washing bath, and the suction needle. The present invention proves a sample suction apparatus that sandwiches the specimen vessel at both ends and pierces the plug with a suction needle ***utilizing a single drive source***. Specification, page 2, lines 3-14. Claim 1 requires – among other things – first, second, and third members capable of linear reciprocation, an elastically compressible spacer between the second and third members, and a suction needle on the third member pointing to the first member. Thus, in addition to requiring three structural members, claim 1 requires specific relationships between the first and third member and between the second and third member.

Claims 1, 2, 4, 6, 7, and 9-11 were rejected under 35 U.S.C. §103(a) as being unpatentable over US 5,578,495 (Wilks) in view of US 6,274,087 (Preston). This ground of rejection is respectfully traversed.

The Examiner concedes that Wilks does not disclose the third member. The question becomes, does Preston suggest adding a third member to the Wilks apparatus, so that said hypothetical third member is separated from Wilks' second member by an elastically compressible spacer and so that a

suction needle is mounted on said hypothetical third member and points to Wilks' first member? The answer is no.

Moreover, in any case, there is no way that the Preston and Wilks disclosures can be combined to suggest employing a single drive source on the hypothetical third member that shifts the first member toward the second member, and that shifts the second and third member toward the first member, and that shifts the third member toward the first member. Although Preston discloses an electric motor 21, dedicated to cause the needle 20 to extend and retract, the motor 21 does not perform "a second action of shifting the second member together with the third member toward the first member until the second member makes contact with another portion of the specimen vessel such that the specimen vessel is sandwiched between the first and second members; and a third action of shifting the third member, against the elasticity of the spacer, toward the first member to bring the third member closer to the second member while maintaining the specimen vessel sandwiched between the first member and the second member such that the suction needle is inserted in the specimen vessel," as recited in claim 1. Accordingly, the combination of Wilks and Preston does not disclose or even suggest the "single drive source" as recited in claim 1.

It is respectfully submitted that the Examiner has failed to make a sustainable *prima facie* case of obviousness based upon the combination of the Preston and Wilks disclosures.

Claims 1, 2, 4, 6, 7, and 9-11 were rejected under 35 U.S.C. §103(a) as being unpatentable over Wilks in view of US 5,240,679 (Stettler). The rejection is respectfully traversed.

The Examiner concedes that Wilks does not disclose the third member. The question becomes, does Stettler suggest adding a third member to the Wilks apparatus, so that said hypothetical third member is separated from Wilks' second member by an elastically compressible spacer and so that a suction needle is mounted on said hypothetical third member and points to Wilks' first member? The answer is no.

Moreover, in any case, the Stettler and Wilks disclosures cannot be combined to suggest employing a single drive source on the hypothetical third member that shifts the first member toward the second member, and that shifts the second and third member toward the first member, and that shifts the third member toward the first member. Thus, Stettler is directed to an apparatus for inserting a pipetting insert into a stopper of a sample vessel. Stettler discloses drive-means 54 that moves a press-in means 55, which guides a plunger 41 into a pipetting insert 11, to an extent such that the pipetting insert 11 is pressed deeply as possible into the stopper 14 to assume the position shown in Fig. 3. The drive-means 54, however, does not perform "a second action of shifting the second member together with the third member toward the first member until the second member makes contact with another portion of the

specimen vessel such that the specimen vessel is sandwiched between the first and second members; and a third action of shifting the third member, against the elasticity of the spacer, toward the first member to bring the third member closer to the second member while maintaining the specimen vessel sandwiched between the first member and the second member such that the suction needle is inserted in the specimen vessel,” as recited in claim 1.

In summary, Wilks merely discloses an elevating motor 221 dedicated for moving moves the upper and lower carriages and Stettler merely discloses motor-means 82 dedicated for moving the pipetting insert 53. None of the prior art of record even suggests or provides motivation to move at least three elements (i.e., the “first member,” the “second member,” and the “third member” of the claimed invention) by using a single drive source.

ARGUMENT. The Examiner argues, in the paragraph bridging pages 2-3 of the Office Action, that “it would have been obvious to modify the device of Wilks by incorporating the movable motor driven needle of Stettler to allow for automation of accessing the vessels without the use of manual force”. The Examiner’s argument (properly) does not go far enough. Even assuming that automation, and adding a third motor, is obvious, it is not obvious to separate the third motor from the second drive member by an elastically compressible spacer and to mount a suction needle on the third motor so that it points to the first member.

The Examiner's attention is respectfully directed to the decision of the Court of Appeals for the Federal Circuit in *In re Kotzab*, 55 USPQ2d 1313. In that case claims were rejected over different items selected from within a **single** reference. The CAFC said that the PTO had fallen into "the hindsight trap" and located within the reference statements that conjecturally could be put together to suggest the claimed invention. But, the Court pointed out, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination **in the manner claimed**. The Court held that the PTO had not made out a proper *prima facie* case of obviousness. Similarly, in the present situation, even assuming, *arguendo*, that Wilks and Stettler can be combined, Wilks in view of Stettler fails to disclose or even suggest the "single drive source" as it is recited in claim 1.

The Examiner has not made out a sustainable *prima facie* case of obviousness.

Claims 2, 4, 6, 7, and 9-11, variously dependent on claim 1, are allowable at least for their dependency upon claim 1.

Conclusion

Accordingly, in view of the above amendments and remarks, reconsideration of the rejections and objections, and allowance of the pending claims are earnestly solicited.

Should there be any outstanding issues to be resolved in the present application, the Examiner is respectfully requested to contact Richard Gallagher (Reg. No. 28,781) at (703) 205-8008.


If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By


Terrell C. Birch, #19,382


TCB:RG/rg:pjh
0397-0430P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000